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09/994,618	11/28/2001	Richard H. Weeks	7118	9254

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08/21/2003

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EXAMINER

ESTRADA, ANGEL R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,618

Applicant(s)

WEEKS, RICHARD H.

Examiner

Angel R. Estrada

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-15, 17 and 24-41 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims Objection

1. Claim 10 line 10, insert --the-- before "top wall". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 19 respectively U.S. Patent No. 6,545,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because both discloses a mounting assembly comprising a junction box, a fixture support provided on the junction

Art Unit: 2831

box, and being movable about an axis extending transversely to the sidewall; a first fixture fastener provided on the fixture support for securing a first size of fixture fastener when the fixture support is in the first use position.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Reiker (US 6,291,768).

Regarding claim 18, Reiker discloses a mounting assembly (see figure 7), comprising: a junction box (130) having a top wall (14) and a downwardly extending side wall (16) defining a cavity therein (see figure 7); a fixture support (134) attached to the junction box (130); a first fixture fastener (154) provided on the fixture support (134); a second fixture fastener (148) provided on the fixture support (134); a third fixture fastener (see figure 7) provided on the fixture support (134); and at least one of the first, second, and third fixture fasteners being movable between a use position and a non-use position (see figure 7).

Regarding claim 19, Reiker discloses the mounting assembly (see figure 7), wherein: each of the first (154), second (148), and third fixture fasteners (see figure 7) has a use position (when the fasteners are use to support a fan or a fixture) and a non-use position (when fasteners are not used).

Regarding claim 20, Reiker discloses the mounting assembly (see figure 7), wherein: when the at least one fixture fastener (154) is in its use position, at least one of the fixture fasteners (148) is in a non-use position (see figure 7).

Regarding claim 21, Reiker discloses the mounting assembly (see figure 7), wherein: the first fixture fastener (154) is sized for securing a first size of fixture fastener (column 4 line 61-64); and one of the second (148) and third fixture fasteners (see figure 7) is sized for securing a second size of fixture fastener (column 4 line 61-64), the second size of fixture fastener differing from the first size of fixture fastener (column 4 line 61-64).

Regarding claim 22, Reiker discloses the mounting assembly (see figure 7), wherein: the fixture support (134) is movable relative to the junction box (column 7 line 9-24).

Allowable Subject Matter

4. Claims 5-8 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2831

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 5-8 and 23 are:

Regarding claims 5-8 is the inclusion therein in combination as currently claimed of the limitation of a mounting assembly wherein the fixture support includes a block

Regarding claim 23 is the inclusion therein in combination as currently claimed on the limitation of the fixture support being rotatable relative to the junction box.

These limitations were found in claims 5-8 and 23, and are neither disclosed nor taught by the prior art of record, alone or in combination.

5. Claims 9-15, 17 and 24-41 are allowed.

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 9-15, 17 and 24-41 are:

Regarding claim 9 is the inclusion therein in combination as currently claimed of the limitation of said fixture support movable between a use position for the first fixture fastener and a non use position for the first fixture fastener; and the use position for the first fixture fastener being a position in which the first fixture fastener faces outwardly away from the top wall, and the non use position for the first fixture fastener being a position in which the first fixture fastener faces outwardly from the top wall.

Regarding claims 10-15 is the inclusion therein in combination as currently claimed of the limitation of said fixture support movable about an axis extending substantially perpendicular to the top wall between a use position and a non use position; and the use position for the first fixture fastener being a position in which the

Art Unit: 2831

first fixture fastener faces outwardly away from the top wall, and the non use position for the first fixture fastener being a position in which the first fixture fastener faces outwardly from the top wall.

Regarding claims 24-27 is the inclusion therein in combination as currently claimed of the limitation of the fixture support being movable about an axis and including a block; the block including a first face and a second face; the first face substantially outwardly away from the top wall when the fixture support is in the first use position; and the second face faces transversely to the top wall when the first face is in the first use position.

Regarding claims 28-31 is the inclusion therein in combination as currently claimed of the limitation the fixture support being movable about an axis and including a block; the block including a first face and a second face; the first face faces substantially outwardly away from the top wall when the fixture support is in the first use position; and the second face faces substantially outwardly away from the top wall when the fixture support is in a second use position.

Regarding claims 32-35 and 17 is the inclusion therein in combination as currently claimed of the limitation the fixture support being movable between a use position and a non use position and including a block; the block including a first face and a second face; the first face substantially outwardly away from the top wall when the fixture support is in the first use position; and the second face faces transversely to the top wall when the first face is in the first use position.

Regarding claim 36 is the inclusion therein in combination as currently claimed of the limitation of said fixture support being movable about an axis extending transversely relative to the side wall between an use portion and a non use position; and the first use position being a position in which the first support extends outwardly away from the top wall, and the first non use position being a position in which the fixture support extends transversely relative to the top wall.

Regarding claims 37-39 is the inclusion therein in combination as currently claimed of the limitation of said fixture support being movable about an axis extending transversely relative to the side wall, said fixture support movable from the first use position to the first non use position and including a block.

Regarding claims 40 and 41 is the inclusion therein in combination as currently claimed of the limitation of said fixture support being movable about an axis extending substantially perpendicular to the top wall between a use position and a non use position and including a block.

These limitations were found in claims 9-15, 17 and 24-41, and are neither disclosed nor taught by the prior art of record, alone or in combination.

Response to Arguments

6. Applicant's arguments with respect to claims 1-4 and 18-22 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2831

Conclusion


7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (703) 305-0853. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for after final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AE

August 8, 2003


DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
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